

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 619.807	
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		First Named Inventor <u>Jerald C. Seelig</u>	
		Art Unit <u>3709</u> Examiner <u>Adetokumbo O. Torimiro</u>	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/95) <input checked="" type="checkbox"/> attorney or agent of record. <u>34351</u> Registration number <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<u><i>Thomas J. Howell</i></u> Signature <u>Thomas J. Howell</u> Typed or printed name <u>775-826-6160</u> Telephone number <u>January 15, 2008</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Seelig et al.

Serial number: 10/811,104

Filed: March 26, 2004

Title: IMAGE ALIGNMENT GAMING DEVICE AND METHOD

Attorney Docket Number: 619.807 ACC.CIP-3D Mix & Match

Group Number: 3709

Examiner: Adetokunbo O. Torimiro

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action dated October 24, 2007, Applicants hereby request a pre-appeal brief review for the above referenced patent application. For the reasons summarized in the accompanying "Concise Description of Deficiencies," Applicants believe that the rejections have clear legal and factual deficiencies.

Key claim elements at issue:

- (1) Is Silkworth a viable reference supporting the rejection under 35 USC §102(b)? Applicants submit that the Examiner has not cited any of the key elements of independent claims 1, 16 and 21 as being present or suggested in Silkworth.
- (2) Is Adams a viable reference used in combination with two groups of two other cited references to support the rejection of independent claims 1, 16 and 21 under 35 USC §103(a)? Does Adams teach or suggest three-dimensional sections arranged to convey a randomly determined game outcome? Is there a motivation to combine all of the three references in each group of cited references to render Applicants claims obvious?

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CONCISE DESCRIPTION OF DEFICIENCIES

• **The Examiner has failed to provide evidence that certain claim limitations are met by the cited reference:**

Claims 1-6, 16 and 21 stand rejected under 35 USC §102(b) as being anticipated by Silkworth (U.S. Patent No. 1,373,679). Silkworth appears to provide a boat race game where game units occupy positions on a turntable to simulate sailboats. Movement of the game units is provided by an air current from a blower which drives the turntable; after the turntable has been stopped, the winning boat is identified by the final position of the boat nearest to the finish line on the turntable.

The Examiner cites Silkworth as teaching: a gaming device having a display object, a support platform, three-dimensional symbols configured to allow a player to view front/back portions of the symbols when the display object is stationary, rotation mechanism controlled by a controller, etc. (Section 3, pp 2-3 of the Final Rejection dated October 24, 2007). However, none of the above alleged cited elements from Silkworth corresponds to any of the key elements of Applicants' independent claims 1, 16 and 21.

None of Applicants' independent claims refers to a display object, a support platform, three-dimensional symbols configured as presented above by the Examiner, or a rotation mechanism controlled by a controller. Applicants see no relevance of these alleged teachings of Silkworth as being pertinent to Applicants' claims. Indeed, key elements of Applicants' independent device claims 1 and 21 include (a) at least one of the three-dimensional figures comprising a plurality of three-dimensional sections where at least one of the latter is moveable relative to the other sections, (b) the three-dimensional sections being positionable to form a whole, integrated image, and (c) a controller to randomly determine a game outcome. None of these claimed elements is cited by the Examiner as being anticipated by Silkworth, nor is any of these elements suggested or taught by Silkworth.

Regarding independent method claim 16, the Examiner has not cited any of Applicants' required method claim elements as being suggested or taught by Silkworth, for example: allowing placement of a wager as part of a game of chance, randomly determining a game outcome involving a controller using a random number generator, or awarding a prize if a selected fractional image and a second fractional image form a predefined, unitary image. The Examiner provides no evidence that the feature of "randomly determining the outcome of the game" is disclosed or suggested anywhere in Silkworth. Indeed, Silkworth provides for "... one of the players, or an outside party ..." to control operation of switch 23 which affords movement (and cessation of movement) of turntable 15 and boats 16 located thereon (see page 1:87-93,103-107 of Silkworth). Thus, one of ordinary skill in the art,

following Silkworth, would expect that a player could control starting and stopping the fan, thereby allowing for the player to rely on skill to affect the game outcome -- this is in direct contrast to Applicants' invention requiring a random determination of the game outcome, such as by use of a random number generator.

Applicants submit that the Examiner has clearly erred in citing Silkworth as a viable reference to support a rejection under 35 USC §102(b) in that (i) all of the cited aspects of Silkworth are not found in Applicants' claims and (ii) key elements of Applicants' independent claims are not cited by the Examiner as being taught by Silkworth. Accordingly, Applicants respectfully request that the final rejection of the claims under 35 USC §102(b) be withdrawn.

• **The Examiner has failed to provide a clear motivation to combine references:**

Claims 1-6, 13 and 14 stand rejected as being obvious under 35 USC §103(a) over Lupo (U.S. Patent Application Publication 2002/0111204) in view of Horvath (U.S. Patent No. 4,405,131) and Adams (U.S. Patent No. 6,334,814). Claims 16-19, 21-23, 25 and 26 stand rejected as being obvious under 35 USC §103(a) over Kaplan (U.S. Patent No. 5,413,342) in view of Horvath (U.S. Patent No. 4,405,131) and Adams (U.S. Patent No. 6,334,814).

For the purposes of this pre-appeal brief review request, Applicants will refer only to **independent claims 1, 16 and 21** in response to the rejection under 35 USC §103(a). Therefore, no discussion of the rejection of dependent claims 7, 8, 10-12, 15, 20, 24, 27 and 28 under 35 USC §103(a) is presented here.

The Examiner has previously rejected the independent claims as being obvious under 35 USC §103(a) over Lupo in view of Horvath (claim 1) and over Kaplan in view of Horvath (claims 16 and 21) -- see the Office Action of May 15, 2007. These rejections were overcome in Applicants' Amendment and Response of August 15, 2007. However, in the Office Action dated October 24, 2007, the Examiner has repeated the rejection of these independent claims under 35 USC §103(a) based on the addition of the newly cited Adams reference to each of the Lupo/Horvath and Kaplan/Horvath combination rejections.

Lupo appears to disclose a three-dimensional Tic-Tac-Toe-type computer game depicting a rotatable playing structure and a number of separate substructures and appears to teach games that depend on logic and deductive skills (see Abstract) where each player is competing with another game player or the game controller, i.e., not activities that involve games of chance or randomly determined game outcomes. Kaplan appears to disclose a slot machine with three or more moving elongated reels

that stop at arbitrary times; the reels include two-dimensional graphic patterns that depict wins by the number of matched patterns. Horvath appears to disclose an improved puzzle device where groups of elements are rotatable about selected orthogonally related axes to move the elements into predetermined relationships, e.g., a RUBIK'S CUBE game, i.e., a game of individual skill and not a game of chance.

The newly cited Adams reference appears to disclose gaming devices including primary and secondary events (such as a TIC-TAC-TOE game having a three-by-three matrix display) capable of providing at least one of a plurality of payouts. The Examiner cites Adams as overcoming apparent deficiencies of the Lupo/Horvath and Kaplan/Horvath combinations, i.e., the lack of teaching (a) a game of chance involving a randomly determined game outcome and (b) the arranging of three-dimensional sections to convey the randomly determined game outcome, and cites from Adams at **col 3:6-25**.

Although Applicants acknowledge that Adams teaches a method of conducting a game of chance, Applicants can find no suggestion or disclosure anywhere in Adams (including **col 3:6-25**) regarding “the arranging of three-dimensional sections to convey the randomly determined game outcome” as alleged by the Examiner. All the payout displays of Adams rely on two-dimensional displays (such as wheels **150/250** in Fig. 2/3 and display **450** in Fig. 7). In addition, neither Adams nor Kaplan teaches or suggests the formation of a “whole integrated three-dimensional image,” a “unitary image” or a “unitary three-dimensional image,” as required by Applicants’ independent claims 1, 16 and 21, respectively.

The Examiner relies on Adams to overcome the acknowledged deficiencies of the Lupo/Horvath and Kaplan/Horvath combinations, i.e., the arranging of three-dimensional sections to convey the randomly determined game outcome. However, Applicants submit that the Examiner has not established a legally sufficient basis for combining the teachings of Lupo/Horvath/Adams or Kaplan/Horvath/Adams because the Examiner has failed to provide sufficient evidence to show that one having ordinary skill in the art would have sufficient motivation to combine the references as suggested by the Examiner (see *Ex Parte Crawford et al.* Appeal 20062429, Decided May 30, 2007).

While both Lupo and Horvath deal with games of skill, Adams is a game of chance; similarly, Kaplan and Adams appear to be games of chance, whereas Horvath is a game of skill. Applicants submit that one of ordinary skill in the art, following the teachings of Lupo/Horvath/Adams would have no incentive to incorporate only selected features of Horvath or Adams when the individual game formats would be incompatible, i.e., skill games versus game of chance. Similarly, there would be no

incentive to incorporate only selected features of Kaplan/Horvath/Adams. The Examiner is relying on improper hindsight (based on Applicants' disclosure) when he suggests selection of only one feature (such as fractional three-dimensional images, allegedly from Adams) from one game format for incorporation into a different incompatible game format.

In addition to erring in characterizing Kaplan as disclosing three-dimensional images (the display reels of Kaplan only present two-dimensional symbols which depict wins by the number of matched patterns), the Examiner further errs by referring to the formation of a "predefined unitary image" in Kaplan at **col 4: 18-21**. This citation from Kaplan refers to the display in **Fig. 4g** where "... all the same symbols are shown in all six windows ..." -- there is no "whole (unitary) integrated three-dimensional image" shown or suggested in **Fig. 4g** of Kaplan, only 3 rows of the same symbol shown in each row of 1, 2 and 3 symbols, in this case triangles or two-dimensional pyramids with spaces (discontinuities) between each symbol in the middle and bottom rows.

In summary, Applicants submit that the Examiner has not established a *prima facie* case of obviousness and that the Examiner's rejection is based on conclusory statements regarding the disclosures of Adams and Kaplan, not supported by the citations presented (see above). In addition, the Examiner has failed to provide satisfactory evidence from Adams to overcome the acknowledged deficiencies of the Lupo/Horvath or Kaplan/Horvath combinations to support the rejection under 35 USC §103(a). Therefore, there is no motivation to combine the teachings of Lupo/Horvath/Adams or Kaplan/Horvath/Adams to arrive at Applicants claimed invention as advanced by the Examiner, except from hindsight reasoning based on Applicants' disclosure.

For all of the above reasons, Applicants respectfully submit that the present application is in condition for allowance. If there are any questions regarding the application or this response, the Review Panel is encouraged to call Applicant's attorney, Ian F. Burns, at (775) 826-6160.

Respectfully submitted,

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